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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,095	02/08/2001	Jean-Louis Gueret	08048.0032-00000	1674
22852 7590 06/21/2010 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER GHALL, ISIS A D				
ART UNIT		PAPER NUMBER		
1611				
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06/21/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/779,095	<b>Applicant(s)</b> GUERET, JEAN-LOUIS	
	<b>Examiner</b> Isis A. Ghali	<b>Art Unit</b> 1611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6, 8-30 and 35-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 8-30 and 35-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
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### **DETAILED ACTION**

The receipt is acknowledged of applicant's amendment filed 05/04/2010.

Claims 2-4, 7, 31-34 have been canceled.

Claims 1, 5, 6, 8-30, 35-68 are pending and included in the prosecution.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 5, 6, 8-30, 35-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

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was filed, had possession of the claimed invention. Independent claims as amended recite "keratinous surface" and this limitation not in the original specification. Applicant refers to page 1 and line 5 for support, however, with careful recourse to the specification, especially page 1, line 5, applicant discloses "treating, making up, or cleaning the skin or the hair". Keratinous surfaces do not only include skin and hair, but further encompass plant surfaces. Therefore, at the time of the invention applicant was not in possession of cleaning all keratinous surfaces as instantly claimed. Applicants did not describe keratinous surfaces other than skin and hair, and applicant not entitled for the full scope of keratinous material.

If applicant contends there is support for this limitation, then applicant is requested to specify the page and line of said support. In accordance to MPEP 714.02, applicant should specifically point out to where in the disclosure a support for any amendment made to the claims can be found.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to one skilled in the art that the inventor had the possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. See *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). See MPEP 2163.06.

The written description requirement prevents applications from using the amendment process to update the disclosure in their disclosures (claims or specification) during the pendency before the patent office. Otherwise applicants could

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add new matter to their disclosures and date them back to their original filing date, thus defeating an accurate accounting of the priority of the invention. See 35 USC 132. The function of description requirement is to ensure that the inventor had possession, as of filing date of the application relied on, the specific subject matter claimed by him.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 5, 6, 8-11, 14-30, 35-60, 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sternfield et al. (US 2,665,528) in view with Smith (US 6,491,928).

Sternfield teaches cleansing tissue comprising from top down: non-woven fabric perforated non-woven layer (10), adhesive layer impregnated with active agent (12), adhesive layer impregnated with active agent (16), non-woven perforated layer (18). The above structure can be continued to form plurality of laminated structure. Non-woven fabric is non-adhesive. Cleansing agent includes fungicides, cleansing agent, and abrasives. The layers are laminated, and not disclosed to be separated from each other, therefore, the adhesive used is permanent adhesive. Upon use the tissue is wetted, it slowly releases the active agent. Abrasive materials read on inert substance claimed by claim 10. Layer (10) has high mechanical strength, i.e. different from layer (18), reads on claim 17. The adhesive layers read on impermeable layer claimed by claim 18. The tissue may adhere to the surface to be cleaned, reads on claim 47. See col.1, lines 1-5, 27-55; col.2, lines 20-55; col.4, lines 46-75; col.5, lines 10-117; col.6, lines 1-5; figure 6.

Although Sternfield desired to clean surfaces by delivering active agent from the tissue when wetted, however, the reference does not explicitly teach wetting with water as instantly claimed by claims 5 and 60, and the absorbent materials in the middle layer as claimed by claim 8, 9, 35-44. Sternfield does not teach the specific adhesives as claimed by claim 14.

Smith teaches an article for personal care application as well as in variety of other industries such as automotive care, marine vehicle care, house hold care, dish care, animal care, etc. where surfaces or areas are in need of cleansing and/or application of benefit agent, e.g. wax, conditioner, UV protectant, etc. (col.2, lines 5-10;

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col.19, lines 28-33). The article comprises first substrate and second substrate and a therapeutic composition disposed in between the two substrates (abstract; figure 3).

The first substrate is perforated and made of permeable materials to enable passage of water to release the active agent and activates the cleansing agent when the article get wet (col.3, lines 50-66). The second substrate is can be apertures (co1.9, lines 35-40).

The substrates layers are made of non-woven material and can be permeable to water, as required by claims 15 and 16, or impermeable, as required by claim 18 (col.3, lines 64-67; col.4, lines 13-16; col.5, lines 23-25). The two non- adhesive substrates can have different texture, as required by claim 17 (co1.3, lines 39- 46). The therapeutic composition comprises cellulose or starches that are claimed by applicant as moisture absorbing compounds in Claims 7 and 9 (col.36, lines 9-11; col. 37, lines 1-2). The reference also teaches gelling agents that also read on moisture absorbing agents and it is present in an amount of 0.1 to 100% that encompasses the amounts claimed in claims 8 and 42 (col.36, lines 18-25). The gelling agents are capable to form a hydrogel and absorb water, and that reads on the limitations of claims 36-41. The therapeutic composition comprises polyamides claimed by applicants as inert materials in claim 10 (col.43, line 59).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an article comprising two outer non-woven layers and an inner adhesive layer containing active agent for cleaning surfaces including skin, vehicles, house hold surfaces, etc as taught by Sternfield, and use water for wetting the article and further add moisture absorbent materials to the adhesive layers as taught by

Smith. One would have been motivated to do so because Sternfield desired to absorb moisture in order to release the active agent from the middle layer(s) and because Smith teaches water activates the cleansing agent and further teaches absorbent particles in the middle layer to achieve water absorption and release of the active agents. One would reasonably expect formulating an article comprising two outer non-woven layer wherein at least one of the outer layers is permeable and inner adhesive layer containing active agent and absorbent materials, wherein the article absorbs water and effectively releases the active agent to clean human skin, hard surfaces of household and vehicles, etc.

Regarding the specific adhesives claimed by claim 14, Sternfield teaches permanent adhesive, and applicant failed to show unexpected results obtained from the specific adhesives claimed by claim 14. Therefore, the adhesives claimed by claim 14 do not impart patentability to the claims, absent evidence to the contrary.

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

6. Applicant's arguments filed 05/04/2010 have been fully considered but they are not persuasive.

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Applicant argues that currently amended claims 1, 27, 54-56, and 68 recites application to keratinous surfaces and the device of Sternfield is not configured to be placed into contact with a keratinous surface region, because the cleansing media and the active agents disclosed by Sternfield are unsuitable for application to keratinous surfaces. Sternfield discloses a device for cleaning heavily soiled surfaces. This configuration is confirmed by the materials employed by Sternfield, such as an abrasive cleansing media which includes "abrasive material. Moreover, each of the three examples listed in column 3 of Sternfield includes at least one irritant and/or caustic material, such as sodium carbonate and tricalcium phosphate, that are unsuitable for contact or use with keratinous surfaces.

In response to these argument, applicant's attention is directed to the scope of the present claims that are directed to product, and all the elements of the product are taught by the cited prior art. The future intended use of the product does not impart patentability to the claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Abrasives taught by Sternfield are used for cleansing skin also. Smith reference, of record, teaches abrasives in the skin cleansing composition, see col.24, line 54. Further, materials taught by Sternfield are suitable for use on the skin and known in the art for use in cosmetics. For example, US 5,350,824 teaches at col.2, lines 59-64 that sodium carbonate are used in cosmetic and it is skin safe. US 4,669,492 using tricalcium phosphate in cosmetic which implies that such materials are skin safe, see claim 1 of the reference.

Applicants argue that each of independent claims 1, 27, and 54-56 has been amended to recite at least one "compound configured to swell within the adhesive matrix upon contact with the solvent to reduce cohesion between the adhesive matrix and the at least

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one active agent," a feature formerly recited in claim 7. The Examiner relies on Smith for teaching of this claim feature. The Examiner alleges that Smith teaches that the therapeutic composition comprises cellulose or starches that are claimed by applicant as moisture absorbing compounds. Smith teaches "hydrogel forming polymeric material" that is "highly absorbent and able to retain water in its absorbed or 'gel' state." However, Smith explains that this material is for creating a 3-dimensional volume which makes a thin substrate feel like a thicker washing cloth. Smith does not specify that these materials are "configured to swell within the adhesive matrix upon contact with the solvent to reduce cohesion between the adhesive matrix and the at least one active agent," as recited in independent claims.

In response to this argument, it is argued that carboxymethyl cellulose and starch taught by Smith are hydrophilic polymers in nature and are capable to absorb water, see for example US 4,883,535, col.2, and lines 41-54. Applicant claimed cellulose and starch as compound configured to swell within the adhesive matrix upon contact with the solvent to reduce cohesion between the adhesive matrix and the at least one active agent, and Smith teaches cellulose and starches that form hydrogel, i.e. absorb water, and Smith teaches the same compounds to absorb water to form hydrogel. The hydrocolloids taught by Smith would display the same claimed properties since materials and their properties are inseparable. If the prior art meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. As such, it is the examiner's position that cellulose and starch in the composition advanced by Smith compositions enumerated in the instant claim set. It has been held that the failure of those skilled in the art to contemporaneously recognize a property, function, or ingredient of a prior art reference does not preclude the presence of these function.

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Applicant argues that one of ordinary skill would not have found any reason to combine the teachings of Smith with those of Sternfield because Sternfield does not disclose devices that are configured to be placed in contact with a keratinous surface region, due to the abrasiveness of the materials and/or the harmfulness of the compounds included. On the other hand, Smith explicitly discloses that the disclosed device is for cleansing skin and hair.

In response to this argument, applicant's attention is directed to the scope of the present claims that are directed to a product, and all the elements of the product are taught by the combination of the prior art. It is further argued that Smith teaching is not only directed to skin and hair as applicant alleged. Smith teaches an article for personal care application as well as for variety of other industries such as automotive care, marine vehicle care, house hold care, dish care, animal care, etc. where surfaces or areas are in need of cleansing and/or application of benefit agent, e.g. wax, conditioner, UV protectant, etc. (col.2, lines 5-10; col.19, lines 28-33). Smith however teaches articles for personal care as preferred embodiment. It has been held that the disclosed examples and preferred embodiment do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Therefore, one having ordinary skill in the art would have been motivated to combine Sternfield with Smith, and reasonable expectation to provide this invention exists as set forth in this office action.

It has been held that: "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of

elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. (2007).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject as a whole matter as defined by the claims would have been prima facie obvious within the meaning of 35 U.S.C. 103 (a).

7. Claims 12, 13, 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sternfield and Smith and further in view of JP 04108710 ('710).

The combined teachings of Sternfield with are discussed above.

However, the references do not teach magnetizable particles in the therapeutic composition as claimed by claims 12, 13, 61-64.

JP '710 teaches cosmetic in adhesive matrix comprising magnetizable particles that are capable of promoting of blood flow to the skin without causing inflammation to the skin (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide an article to clean skin and other surfaces comprising two non-adhesive layers and a middle layer disposed in between the non-adhesive layers and comprises adhesive material and active agent as taught by the Sternfield, and add magnetizable particles to the active agent containing layer as taught by JP '710. One would have been motivated to do so because JP '710 teaches that the magnetizable particles are capable of promoting the blood flow to the skin without causing its inflammation. One would reasonably expect formulating an article comprising two outer layers and middle adhesive layer comprising magnetizable particles that promotes the blood flow to the skin without causing its inflammation.

### ***Response to Arguments***

8. Applicant's arguments filed 05/04/2010 have been fully considered but they are not persuasive.

Applicants further argue that Yoko is cited only for teaching of a "cosmetic in adhesive matrix comprising magnetizable particles, and fails to cure the above-noted deficiencies of Sternfield. Therefore, the cited art does not disclose or suggest all of the recited features of independent claim 61.

In response to this argument, as applicant admits, Yoko is cited solely for teaching of a "cosmetic in adhesive matrix comprising magnetizable particles". As stated before, the combination of Sternfield and Smith teaches article for cleansing skin or other hard surfaces, and based on the intended use, one having ordinary skill in the art would add magnetic particles. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IG

/Isis A Ghali/  
Primary Examiner, Art Unit 1611